

Therefore, claim 1 is, in fact, a proper generic claim. As such, in the present case, an election of species requirement is permissible, but a restriction requirement is *not*.

Moreover, because the Second Restriction Requirement splits a single claim, *i.e.*, claim 1, into multiple groups, *i.e.*, *eight* groups A-H, the Second Restriction Requirement is improper as a matter of law. The courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. See, *In re Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and *In re Haas* 198 USPQ 334-337 (*In re Haas II*) (CCPA 1978). As stated in *In re Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim—no matter how broad, which means no matter how many independently patentable inventions may fall within it. 198 USPQ 328 at 334.

As such, the Examiner's statement that "these products [the sequences set forth in Groups A-H] appear to constitute patentably distinct inventions" is not proper grounds for issuing a Second Restriction Requirement on the claims set forth in Group I, claims 1-21 and 36-37 (*see*, page 5 of the Restriction Requirement). Again, as mentioned above, the courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions.

Moreover, in a case such as the instant case, where claim 1 is generic, the Second Restriction Requirement is tantamount to a rejection of claim 1. The CCPA made this point very clear in *In re Haas I*:

We find that the action taken by the examiner did in fact amount to a rejection. . . . Those claims were withdrawn from consideration not only in this application but prospectively in any subsequent

application because of their content. In effect there had been a denial of patentability of the claims. Presumably only by dividing the subject matter into separate, and thus different, claims in plural applications could an examination of the patentability of their subject matter be obtained. 179 USPQ at 625.

If the Second Restriction Requirement is allowed to stand, Applicants will never be accorded “the basic right of the applicant to claim his invention as he chooses.” *In re Weber*, 198 USPQ at 331. In *In re Weber*, the CCPA stated that “[a]s a general proposition, an applicant has a right to have *each* claim examined on the merits” (198 USPQ at 331, emphasis in original). The Court went on to state that:

If . . . a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. 198 USPQ at 331.

Even if Applicants were to file *eight* divisional applications to obtain coverage for the sequences recited in each of the *eight* groups set forth in the Second Restriction Requirement, they would not have the opportunity to have their broader claim examined. The claims of the *eight* divisional applications would be limited to the particular species set forth in each of the *eight* respective groups. In effect, the Second Restriction Requirement is reading into Applicants’ independent claim limitations that are not present in the claim as filed. Claim 1, for example, would never be considered under the current Restriction Requirement. Only the dependent claims which are set forth in the respective groups A-H would be examined.

For at least the foregoing two reasons, the Second Restriction Requirement set forth by the Examiner is improper and should be withdrawn.

Notwithstanding the foregoing, pursuant to 37 C.F.R. § 1.144, Applicants reserve the right to petition for review of the Restriction Requirement at any time prior to appeal.

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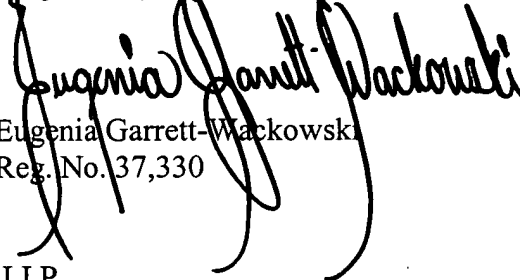
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Applicants also note that because the instant rejection is tantamount to a rejection of the generic claim, the restriction requirement is appealable to the Board of Patent Appeals and Interferences.

In re Haas, supra.

If the Examiner has any questions regarding Applicants' election, or if the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (925) 472-5000.

Respectfully submitted,



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